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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,737	06/01/2001	Thomas A. Soulanille	9623/324	3926

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EXAMINER	
LE, UYEN T	
ART UNIT	PAPER NUMBER
2171	5

DATE MAILED: 04/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/872,737	SOULANILLE, THOMAS A.	
	Examiner	Art Unit	
	Uyen T Le	2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453_O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4. 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows: the present application is not filed with at least one common inventor with application 09/322,677 now US Patent 6,269,361 from which it claims priority. Therefore, this application is not examined as a continuation-in-part of application 09/322,677.

Information Disclosure Statement

2. The information disclosure statement filed 25 January 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "bid amount-weighted random drawing", the "bid rank-weighted random drawing" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

4. The drawings are further objected to because of discrepancies between the specification and the Figures:

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- Figures 10, 11 show variable B at block 216. However, the specification mentions a variable V at block 216
- Figure 10 shows a formula having the variable w without a block defining w
- Figure 12 shows block 402 as "initialize V". However, the specification mentions that "at block 402, a variable V is set to the sum of the bids of the listings in the Selection List"
- Figure 13 shows the symbol of -s without a block defining s.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because:

- it contains an embedded hyperlink and/or other form of browser-executable code at page 11. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01
- it contains typographical errors at page 23, line 8
- it contains discrepancies between the specification and the drawings for example at page 37, line 31, the specification mentions a variable V at block 216.

However, Figure 10 shows a variable B. At page 39, line 27, the specification mentions a variable V at block 216. However, Figure 11 shows a variable B.

Applicant is requested to review the whole specification and make appropriate corrections.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 7-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 7-12, the “random order weighted”, “bid amount-weighted random drawing”, “bid rank-weighted random drawing” are not understood, therefore the limitations can not be ascertained. It is not clear how the order of the listing can be random and weighted at the same time.

The art rejection of claims 7-12 is applied as best understood in light of the rejection under 35 U.S.C. 112, first and second paragraphs discussed above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 7-13 are rejected under 35 U.S.C. 102(a), (e) as being anticipated by Davis et al (US 6,269,361).

Regarding claim 7, Davis discloses all the claimed subject matter (see the abstract, column 4, line 51- column 6, line 34). The claimed "receiving a search request from a searcher" is met when Davis shows the search engine for clients to search (see Figure 1, column 10, lines 7-20). The claimed "in a database...match with the search request" is met by the fact that advertisers in the method of Davis bid for a position in the search listing and accounts of advertisers include search terms (see column 5, lines 18-40, column 9, lines 42-45). The claimed "selecting... searcher" is met by the fact that the method of Davis limits search listings to a geographical area for example (see column 17, lines 19-45). The claimed "arranging...searcher" is met by the fact that the search results are displayed according to the bid amount and presented to searchers (see column 5, lines 30-40).

Claim 8 merely reads on the fact that the method of Davis, the highest bid listing is displayed before the lower bid listing (see column 18, lines 4-35).

Claim 9 is met when Davis shows that the listings are ordered by bid amount (see column 5, lines 35-40).

Claims 10-12 merely differ from claims 7-9 above by reciting "bid rank" instead of "bid amount". Davis explicitly shows the claimed bid rank (see column 13, lines 16-20, column 18, lines 4-35).

Claim 13 merely differs from claim 7 by not reciting "selecting no more than a predetermined number of identified search listings". Davis discloses all the claimed subject matter as discussed in claim 7 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al (US 6,269,361).

Regarding claim 1, Davis discloses all the claimed subject matter except the random order of the search listings (see the abstract, Figure 1, column 4, line 51- column 6, line 34). The claimed "receiving a search request from a searcher" is met when Davis shows the search engine for clients to search (see Figure 1, column 10, lines 7-20). The claimed "in a database...match with the search request" is met by the fact that advertisers bid for a position in the search listing in the method of Davis and that accounts of advertisers include search terms (see column 5, lines 18-40, column 9, lines 42-45). The claimed "selecting... searcher" is met by the fact that the method of Davis limits search listings to a geographical area for example (see column 17, lines 19-45). The claimed "communicating...searcher" is met by the fact that the search results are displayed to searchers (see column 8, line 52- column 9, line 3). Although Davis does not specifically show displaying the search listings in a random order, it would have been obvious to one of ordinary skill in the art to do so in order to arbitrarily present paid listings without having to rank them.

Regarding claims 2, 3 since the listings are displayed in a random order, clearly the order changes periodically upon subsequent receipt of the search request.

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Claims 4, 5 merely read on the fact that the method of Davis detects the change in bid amount and adjusts the order accordingly (see column 18, lines 4-18).

Claim 6 merely reads on the fact that the method of Davis also lists unpaid listings following the lowest-ranked paid listing (see column 18, lines 25-27).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen T Le whose telephone number is 703-305-4134. The examiner can normally be reached on M-F 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Uyen Le
April 4, 2003